

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND R. HORTON,
CHANDRASEKHAR NARAYAN and
MICHAEL J. PALMER

Appeal No. 1998-1813
Application 08/476,178

RECONSIDERATION

Before THOMAS, HAIRSTON, and JERRY SMITH, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

REQUEST FOR REHEARING

In a paper filed January 3, 2001, appellants request that we reconsider our decision dated November 8, 2000, wherein we sustained only the rejection of claims 6 through 10 under 35 U.S.C. § 103. In that decision, we reversed the examiner's rejection of independent claims 13 and 14 and their respective dependent claims 2 through 5 and 12. Appellants' request for rehearing sets forth three basic points.

Appellants' disclosed basis under which the claimed invention is recited is most aptly reflected in the description in the specification in the paragraph bridging pages 5 and 6 stating "the reflection of the upper object to be detected in the surface of the lower substrate and relative motion imparted to the substrates eliminating the reflection produces alignment." In a summary manner at page 7 of the specification as filed it is stated that "alignment of superpositioned objects on opposing substrates is achieved through relative movement of the substrates responsive to an image of one object reflected from the surface of the opposite substrate."

Our original opinion carefully parsed the language of respective independent claims 13, 14 and 6 to indicate the recitations therein in claims 13 and 14 that led us to conclude the rejection of these claims and their respective dependent claims must be reversed yet also conclude the unpatentability under 35 U.S.C. § 102 of independent claim 6 and its respective dependent claims. The above-quoted portions of the specification as filed are most aptly reflected in independent claim 13 as generally expressed in our original opinion at page 3. Claim 13 was said to specifically recite that the reflected light is from the supporting substrate as a distinguishing factor over the teachings of the applied reference. Similarly, we noted that the reference did not determine any reduction of any reflected light according to the operation of the reference's system in Figure 2 but that which is recited at the end of claim 13 on appeal. Neither of these features are recited in independent claim

6 on appeal. The features of independent claim 14 were discussed at page 4 of our original opinion where we indicated the basis of our reversal of the rejection of this claim because it contained a recitation of the relative movement of the substrates to bring together or otherwise align the first and second substrates that was stated to be in response to the elimination of the claimed reflection. Again, this feature is not recited in independent claim 6 as our opinion at pages 4 and 5 so indicates.

Our discussion of claim 14 at page 4 of our original opinion indicates that the reflection of the image in this claim is different than the reflection in independent claim 13 and, at the same time, we indicated that the recitation in claim 6 is comparable to that in claim 14. Claim 6 requires that the observation of a reflected image be “of a first conductor on an area of said first substrate” where the meaning of this language is that the first conductor must be physically on the area of the first substrate. The claim does not require that a reflected image be from a substrate as recited in independent claim 13 on appeal. This was explained in detail in the paragraph bridging pages 4 and 5 of our original opinion. Claim 6 states that the first conductor is on the first substrate and not that a reflected image comes from any substrate at all. We also sustained the rejection of claim 6 because there is no positive statement of any alignment occurring as contemplated at line 4 of claim 6 by the recited means for relatively moving at the end of this claim.

Page 3 of our original opinion indicated that our understanding of L'Esperance is that a visual comparison is made between the light reflected from the actual surfaces of the conductive members 16 and 18 as in Figure 2 and not from the surfaces of the integrated circuit chip 12 or of the substrate 14. The reflected image recited in claim 6 is consistent with this teaching as our original opinion indicated.

Therefore, as to appellants' first point, appellants effectively argue at pages 1 and 2 of the request for rehearing the disclosed rather than the claimed invention as it applies to the recitations in claim 6. Our decision as well as our amplification here makes clear that we fully understand the optical principles on which the claimed invention is intended to be recited but it is not recited in such a degree of specificity in claim 6 as is required to distinguish over the applied prior art as in the other independent claims 13 and 14 on appeal. A careful consideration of our affirmance as to claim 6 in the original opinion as well as the amplifying comments in this opinion as to claim 6 make clear that the language of this claim is not as specific in more than one respect as is the language setting forth the features of independent claims 13 and 14 on appeal on which we reversed the rejection. Therefore, we remain unpersuaded of any error of our original opinion as to appellants' second point. Finally, as to the third point at page 3 of the request for rehearing, the term "image" as recited in the respective claims on appeal has been clearly understood by us. There is no ambiguity in each of the recited claims as to the meaning of the term causing

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us to ascertain any further meaning from the specifications' teachings. We, at the same time, will not read any limitations of the specification into the claims to further limit them.

In view of the foregoing, appellants' request for rehearing is granted to the extent that we have, in fact, reviewed our findings, but is denied as to making any change therein.

REHEARING DENIED

James D. Thomas)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
Kenneth W. Hairston)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Jerry Smith)	
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